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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,745	11/12/2003	Vivek Y. Reddy	035249/US-475387-73	7530
30873 7590 12/14/2007 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT 250 PARK AVENUE NEW YORK, NY 10177			EXAMINER MEHTA, BHISMA	
			ART UNIT 3767	PAPER NUMBER
			MAIL DATE 12/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,745

Applicant(s)

REDDY ET AL.

Examiner

Bhisma Mehta

Art Unit

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-34,36-50 and 52-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-34,36-50 and 52-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to disclose the energy source being provided to activate the fluid to destroy at least one of a plurality of cells and a tissue within the target area.

Claim Objections

2. Claims 27-34, 36-50, and 52-55 are objected to because of the following informalities: Claims 27 and 37 recite the limitation "the liquid" in line 6. There is insufficient antecedent basis for this limitation in these claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 27-36, 53, and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention. The recitation of the liquid being provided to be received only by those areas of the heart having a metabolism which is less than or equal to the predetermined metabolism is not described in the specification. In fact, this recitation is contradictory to what Applicant discloses in lines 9-12 of paragraph [0017].

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 27-34, 36-50, and 52-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Lardo (Patent Application Publication No. 2002/0095197). Lardo et al disclose an arrangement for treating cardiac arrhythmia comprising a fluid delivery system (4) structured to systemically or locally introduce a fluid to a target area of a heart and an energy source (3) adapted to transmit energy in the form of light to at least one portion of the target area. The fluid delivery system is structured such that it is capable of introducing a fluid to a target area of a heart where a volume of the target area which receives the fluid is less than a volume of the heart and where the target area has a predetermined metabolism and the fluid/liquid is provided to be received only by those areas of the heart having a metabolism which is greater than or equal to or less than or equal to the predetermined metabolism. In paragraph [0028], Lardo et al

teach using a photodynamic or photosensitizing compound. In paragraph [0027], Lardo et al teach activation of the compound causes damage to those cells in which the compound has been localized. In paragraph [0033], Lardo et al teach the energy source may be used to determine electrical activity within the heart. In paragraph [0037], Lardo et al teach that the energy source is provided to activate the fluid to destroy at least one of a plurality of cells and a tissue within the target area.

7. Claims 27-34, 36-50, and 52-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Pless (U.S. Patent No. 6,811,562). In lines 47-59 of column 9, Pless discloses an arrangement for treating cardiac arrhythmia comprising a fluid delivery system structured to systemically or locally introduce a fluid to a target area of a heart and an energy source (300) adapted to transmit energy in the form of light to at least one portion of the target area. The fluid delivery system is structured such that it is capable of introducing a fluid to a target area of a heart where a volume of the target area which receives the fluid is less than a volume of the heart and where the target area has a predetermined metabolism and the fluid/liquid is provided to be received only by those areas of the heart having a metabolism which is greater than or equal to or less than or equal to the predetermined metabolism. In lines 1-18 of column 9, Pless teaches using a photodynamic or photosensitizing compound and teaches that activation of the compound causes damage to those cells in which the compound has been localized. In lines 47-60 of column 2, Pless teaches energy source may be used to determine electrical activity within the heart. In lines 19-31 of column 9, Pless

teaches that the energy source is provided to activate the fluid to destroy at least one of a plurality of cells and a tissue within the target area.

Response to Arguments

8. Applicant's arguments with respect to claims 27-34, 36-50, and 52-55 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument filed October 12 2007 that Lardo et al and Pless do not disclose a fluid delivery system structured to introduce a fluid to a target area in which the target area has a predetermined metabolism and the fluid/liquid is provided to be received only by those areas of the heart having a metabolism which is greater than or equal to or less than or equal to the predetermined metabolism, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Both Lardo et al and Pless disclose the claimed structural limitations, and, therefore, are seen as being capable of performing the intended use which is recited in the claims. There are no structural differences between the claimed invention and the prior art, thus demonstrating that if the claimed invention can perform the intended use as recited in the claims, then the prior art is also capable of performing the same intended use.

Application/Control Number:
10/706,745
Art Unit: 3767

Page 6

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bhisma Mehta whose telephone number is 571-272-3383. The examiner can normally be reached on Monday through Friday, 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



BM

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

